



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,753	06/01/2001	Gregory Scott Friedman	05146.00005	9903

7590 05/20/2004

Robert D. Becker
Manatt, Phelps & Phillips, LLP
1001 Page Mill Road
Building 2
Palo Alto, CA 94304

EXAMINER

BAKER, PAUL A

ART UNIT	PAPER NUMBER
----------	--------------

2188

DATE MAILED: 05/20/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,753

Applicant(s)

FRIEDMAN ET AL.

Examiner

Paul A Baker

Art Unit

2188

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

Applicant's submission of a Request for Continued Examination under 37 CFR §1.114 is acknowledged.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7,9-10,14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Chan et al. "Application of Compaction Technique to Optimizing Wireless Email Transfer".

In regards to claim 1, Chan discloses a method of caching information relating to a set of data items, comprising:

in a first retrieval operation, retrieving and storing into a memory only a first hierarchical level of information corresponding to at least one of the data items on page 1534 Section III 3rd paragraph lines 9-12; and

in a second retrieval operation separate from the first retrieval operation, retrieving and storing into the memory only a second hierarchical level of information corresponding to the at least one of the data items page 1534 Section III 3rd paragraph lines 10-21.

In regards to claim 2, Chan discloses the data items are electronic data files page 1534 Section III 3rd paragraph lines 1-2.

In regards to claim 3, Chan discloses the electronic data files are electronic mail message data files page 1534 Section III 3rd paragraph lines 1-2.

In regards to claim 4, Chan discloses the first level of hierarchical information is at least one identifier for uniquely identifying each of the at least one of the data items page 1534 Section III 3rd paragraph lines 9-12.

In regards to claim 5, Chan discloses the second level of hierarchical information is metadata for each of the at least one of the data items page 1534 Section III 3rd paragraph lines 1-5.

In regards to claim 6, Chan discloses the metadata includes one or more data selected from the group consisting of: a title of the at least one of the data items, a subject of the at least one of the data items, an author of the at least one of the data items, and a size of the at least one of the data items page 1534 Section III 3rd paragraph lines 1-5.

In regards to claim 7, Chan discloses the second level of hierarchical information is content for each of the at least one of the data items page 1534 Section III 3rd paragraph lines 1-5.

In regards to claim 9, Chan discloses in a third retrieval operation separate from the first and second retrieval operations, retrieving and storing into the memory only a third hierarchical level of information corresponding to the at least one of the data items page 1534 Section III 3rd paragraph lines 7-9.

In regards to claim 10, Chan discloses the third level of hierarchical information is content for each of the at least one of the data items page 1534 Section III 3rd paragraph lines 7-9.

In regards to claim 14, Chan discloses the first retrieval operation is initiated in response to receiving a first trigger page 1534 Section III 3rd paragraph lines 6-8, and the second retrieval operation is initiated in response to receiving a second trigger different from the first trigger page 1534 Section III 3rd paragraph lines 10-12.

In regards to claim 15, Chan discloses at least one of the first trigger and the second trigger is predictive indicator predicting a user's preferences for retrieving information from the set of data items page 1534 Section III 3rd paragraph lines 10-12.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Chan et al. "Application of Compaction Technique to Optimizing Wireless Email
Transfer" in view of Ulrich et al. US Patent 6,052,735.

In regards to claim 8, Chan does not disclose the second level of hierarchical information is an attachment to each of the at least one of the data items. Ulrich discloses in column 3 lines 15-21 dynamically retrieving attachments on a per message basis. Both Chan and Ulrich are systems to reduce unnecessary bandwidth on a slow interconnect when synchronizing email between a personal device and a source. It is well known in the art that email is comprised of multiple sections one of which is an optional attachment. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to transfer attachments within Chan as part of the hierarchical retrieval of information.

In regards to claim 11, Chan does not disclose the third level of hierarchical information is an attachment to each of the at least one of the data items. Ulrich discloses in column 3 lines 15-21 dynamically retrieving attachments on a per message basis. Both Chan and Ulrich are systems to reduce unnecessary bandwidth on a slow interconnect when synchronizing email between a personal device and a source. It is well known in the art that email is comprised of multiple sections one of which is an

optional attachment. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to transfer attachments within Chan as part of the hierarchical retrieval of information.

In regards to claim 13, Chan does not disclose the fourth level of hierarchical information is an attachment to each of the at least one of the data items. Ulrich discloses in column 3 lines 15-21 dynamically retrieving attachments on a per message basis. Both Chan and Ulrich are systems to reduce unnecessary bandwidth on a slow interconnect when synchronizing email between a personal device and a source. It is well known in the art that email is comprised of multiple sections one of which is an optional attachment. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to transfer attachments within Chan as part of the hierarchical retrieval of information.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. "Application of Compaction Technique to Optimizing Wireless Email Transfer". Chan does not explicitly disclose a fourth retrieval operation separate from the first, second and third retrieval operations, retrieving and storing into the memory only a fourth hierarchical level of information corresponding to the at least one of the data items. However it is well known in the art that email is comprised of multiple sections such as the unique identifier, header information (such as the sender, subject and size) the message body, and attachments. Since Chan addresses sending in hierarchical

fashion the first three elements, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a fourth retrieval operation for the purpose of retrieving attachments.

Response to Arguments

Applicant's arguments filed a request for reconsideration on 19 April 2004 have been fully considered but they are not persuasive.

While Chan et al. "Application of Compaction Technique to Optimizing Wireless Email Transfer" is drawn to the compaction of email transfers over limited bandwidth channels using reference objects in cache, Chan performs applicant's claimed invention as a means of achieving his main objective. Chan's use of reference objects is not germane since they are for use in the compaction portion of Chan's invention. Applicant states examples of hierarchical levels of information as an identifier, metadata, file content, text content, and image content. Chan discloses sending descriptions of emails to a client such as name, date, message length, subject (section 3 lines 9 and 10), unique identifier (Section 3 lines 14-17) and finally the message body (Section 3 lines 17-20). Chan's first three examples are metadata, so it is clear that Chan's descriptors and applicant's hierarchical levels of information are equivalent.

Ulrich discloses transferring electronic mail (email) attachments to a mobile device based on a set of filters or by the user manually selecting the attachment for transfer. By applicants own admission email attachments are a form of hierarchical

information as stated in claim 8 and restated in applicant's remarks. Therefore the examiner respectfully maintains the rejection of applicant's claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A Baker whose telephone number is (703)305-3304. The examiner can normally be reached on M-F 10am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mano Padmanabhan can be reached on (703)306-2903. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PB

Mano Padmanabhan
5/17/04

MANO PADMANABHAN
SUPERVISORY PATENT EXAMINER